

### REMARKS

Applicants respectfully request reconsideration of this application as amended.

**As a preliminary matter, in the Office Action mailed November 30, 2004, the Office Action states that a priority claim was not included in the specification filed May 9, 2001. The priority claim was included in the Preliminary Amendment that was filed with the specification on May 9, 2001, a copy is attached along with the PTO return stamped postcard acknowledging receipt of the Preliminary Amendment.**

### Office Action Rejections Summary

Claims 33-43 have been rejected under 35 U.S.C. §112, first paragraph.

Claims 22 and 34-43 have been objected to for informalities.

Claims 11-32 have been allowed.

### Status of Claims

Claims 11-43 are pending in the application. Claims 22 and 34-43 have been amended to provide for proper antecedent basis. The amended claims are supported by the specification. No claims have been added. No new matter has been added. No claims have been canceled. Claims 11-32 have been allowed. Therefore, the following comments are directed to the objected and rejected claims.

### Claim Objections and Rejections

Claims 22 and 34-43 have been objected to for informalities. It is submitted that the amendments to the claims overcomes the objections.

Claims 33-43 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. It is submitted that the claims 33-34

comply with the written description requirement of 35 U.S.C. §112, first paragraph. In particular, the specification states:

The invention provides a method and system for providing unique ATM End System Addresses . . . (Specification, page 3, lines 15-16)

Those skilled in the art would recognize after perusal of this application that embodiments of the invention can be implemented using general purpose switching processors or special purposes switching processors or other circuits adapted to particular process steps and data structures described herein, and that implementation of the process steps and data structures described herein would not require undue experimentation or further invention. (Specification, page 4 lines 16-22)

Although in a preferred embodiment, a switch is typically a single device, a switch may also comprise a plurality of devices comprising a switching system, such as a set of one or more physical acting together as a single PNNI network management entity. (Specification, page 8, lines 6-9)

When the device is coupled to an ATM network, the ATM address 100 is autoconfigured to the values shown herein. (Specification, page 9, lines 11-12).

Accordingly, it is submitted that an ATM communications component, a memory storage component and an interface are described within in the specification of the application in such a way as to reasonably convey to one of skill in the art that the inventors, at the time of the application was filed, had possession of the claimed invention. As noted above, the detailed description describes that the device contains circuitry to implement the process steps described therein and provides some preferred embodiments. For example, the specification describes a device that is coupled to an ATM network and, accordingly, one of skill in the art would understand that such a device contains circuitry to perform a function of communicating on the ATM network or, in other words, an ATM communications component. Applicants wish to respectfully note that **the subject matter of a claim need not be described literally (i.e., using the same terms of in haec verba) in order for the disclosure to satisfy the description requirement. MPEP 2163.02.** Therefore, it is requested that the rejection with respect to claims 33-43 be removed.

Furthermore, should the Examiner continue to challenge the adequacy of the written description, it is respectfully submitted that the Examiner has the initial burden of presenting by a preponderance of evidence, reasons why a person skilled in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims. MPEP 2163.04 In re Wertheim, 541 F.2d 257, 263 (CCPA 1976). It is respectfully submitted that the Office Action has only provided a conclusionary statement regarding the lack of purported support for the claim limitations without providing reasons why a person of ordinary skill in the art would not recognize in the applicants' disclosure a description of the claim limitations of an ATM communications component, a memory storage component, and an interface to implement the methods described therein.

In conclusion, applicants respectfully submit that in view of the arguments and amendments set forth herein, the applicable objections and rejections have been overcome.


If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Daniel Ovanezian at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 2/17, 2005

  
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**FIRST CLASS CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

on \_\_\_\_\_

2/17/05  
Date of Deposit

JUANITA BRISCOE

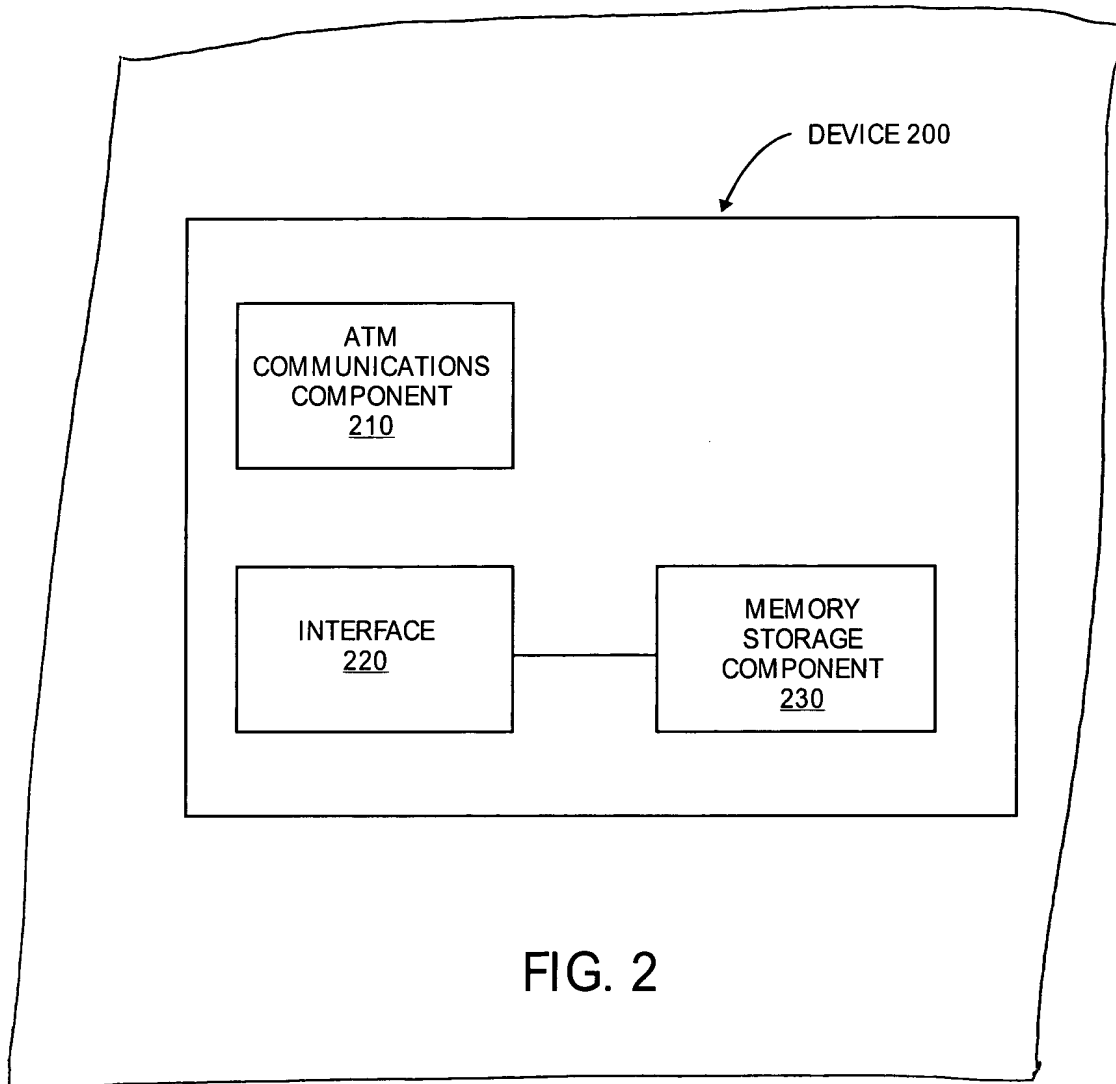
Name of Person Mailing Correspondence

Juanita Briscoe  
Signature

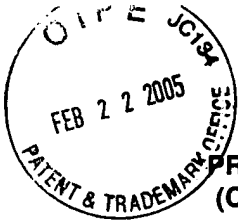
2/17/05  
Date



APPLICATION NO. 09/852,755  
REPLY TO OFFICE ACTION OF NOVEMBER 30, 2004  
ANNOTATED SHEET SHOWING CHANGES



added new Figure 2



(BEST AVAILABLE COPY)

**PRELIMINARY AMENDMENT FOR CONTINUING APPLICATION  
(CONTINUATION, DIVISIONAL, OR CONTINUATION-IN-PART)**

First Named Inventor Ethan Spiegel

Title FORMAT FOR AUTOMATIC GENERATION OF UNIQUE ATM ADDRESSES USED FOR PNNI

Attorney Docket No. \_\_\_\_\_

**Parent Application:**

First Named Inventor Ethan Spiegel

Title FORMAT FOR AUTOMATIC GENERATION OF UNIQUE ATM ADDRESSES USED FOR PNNI

Application No. 08/876,952

Examiner: F. Duong

Filing Date June 17, 1997

Group Art Unit: 2731

Applicant(s): If the present patent application is a Continuation, Divisional, or Continuation-In-Part application under 37 CFR § 53(b) of a parent application, then submit this Preliminary Amendment to the PTO. Please insert the appropriate claim for priority, listing the entire chain of priority.

**To: Assistant Commissioner for Patents  
Washington, D.C. 20231**

Sir:

Please enter the following preliminary amendment for the present patent application.

**IN THE SPECIFICATION:**

At page 1, line 2, please insert the following:

-- The present patent application is a

     Continuation     X     Divisional      Continuation-in-part (CIP)

of prior application no. 08/876,952, filed June 17, 1997, entitled FORMAT FOR AUTOMATIC  
GENERATION OF UNIQUE ATM ADDRESSES USED FOR PNNI

which is a      continuation/      divisional/      CIP of prior application no. \_\_\_\_\_,

which is a      continuation/      divisional/      CIP of prior application no. \_\_\_\_\_.

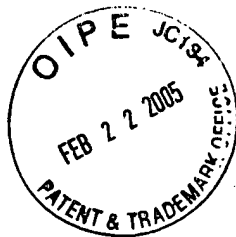
May 9, 2001  
Date

Stephen T. Neal  
Signature

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MAY 21 2001

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN  
LOS ANGELES

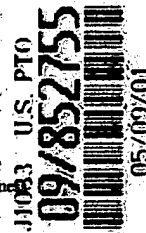
STATUS REPORT

Serial/Patent No.: \*\*\* Filing/Issue Date: \*\*\*  
Client: Cisco Technology, Inc.  
Title: Format For Automatic Generation of Unique ATM Addresses Used For PNNI  
BSTZ File No.: 081862P232D Atty/Secty Initials: LJV/STN/lm/lr/bks  
Date Mailed: 5/9/01 Docket Due Date: \*\*\*

The following has been received in the U.S. Patent & Trademark Office on the date stamped hereon:

- |   |  |  |
|---|--|--|
| <input type="checkbox"/> Amendment/Response (____ pgs.)                                       | <input checked="" type="checkbox"/> Express Mail No.: <u>EL627469023US</u>           | <input checked="" type="checkbox"/> Check No. <u>42710</u> |
| <input type="checkbox"/> Appeal Brief (____ pgs.) (in triplicate)                             | <input type="checkbox"/> _____ Month(s) Extension of Time                            | Amt: <u>944.00</u>   |
| <input type="checkbox"/> Application - Utility (____ pgs., with cover and abstract)           | <input type="checkbox"/> Information Disclosure Statement & PTO H40 (____ pgs.)      | <input type="checkbox"/> Check No. _____                   |
| <input type="checkbox"/> Application - Rule 1.53(b) Continuation (____ pgs.)                  | <input type="checkbox"/> Issue Fee Transmittal                                       | Amt: _____   |
| <input checked="" type="checkbox"/> Application - Rule 1.53(b) Divisional ( <u>12</u> pgs.)   | <input type="checkbox"/> Notice of Appeal  |  |
| <input type="checkbox"/> Application - Rule 1.53(b) CIP (____ pgs.)                           | <input type="checkbox"/> Petition for Extension of Time                              |  |
| <input type="checkbox"/> Application - Rule 1.53(d) CPA Transmittal (____ pgs.)               | <input type="checkbox"/> Petition for _____  |  |
| <input type="checkbox"/> Application - Design (____ pgs.)                                     | <input checked="" type="checkbox"/> Postcard   |  |
| <input type="checkbox"/> Application - PCT (____ pgs.)  | <input type="checkbox"/> Power of Attorney (____ pgs.)                               |  |
| <input type="checkbox"/> Application - Provisional (____ pgs.)                                | <input checked="" type="checkbox"/> Preliminary Amendment ( <u>18</u> pgs.)          |  |
| <input type="checkbox"/> Assignment and Cover Sheet   | <input type="checkbox"/> Reply Brief (____ pgs.)                                     |  |
| <input checked="" type="checkbox"/> Certificate of Mailing                                    | <input type="checkbox"/> Response to Notice of Missing Parts                         |  |
| <input checked="" type="checkbox"/> Declaration & POA ( <u>2</u> pgs.) (Copy)                 | <input type="checkbox"/> Small Entity Declaration for Indep. Inventor/Small Business |  |
| <input type="checkbox"/> Disclosure Docs & Orig & Copy of Invention Signed Letter (____ pgs.) | <input type="checkbox"/> Transmittal Letter, in duplicate                            |  |
| <input checked="" type="checkbox"/> Drawings: <u>1</u> # of sheets includes <u>16</u> figures | <input checked="" type="checkbox"/> Fee Transmittal, in duplicate                    |  |

☒ Other: Certificate of Express Mail with copy of postcard showing contents of package.



Due date 8/9/2001 Client Name Cisco Technology, Inc.  
Docket Initial \_\_\_\_\_ 81862 . P232D  
Docket Sup. Initial MM  
Atty/Initial LJV STN  
Pat/Ser/Reg 852,755 19

Description

month deadline to file prior art disclosure and check related cases based on filed US application).

2/22/2001

Natalie Adair

Due date 11/9/2002 Client Name Cisco Technology, Inc.  
Docket Initial \_\_\_\_\_ 81862 . P232D  
Docket Sup. Initial MM  
Atty/Initial LJV STN  
Pat/Ser/Reg 852,755 23

Description

Watch for first office action

2/22/2001

Natalie Adair